

REMARKS

Reconsideration and allowance in view of the foregoing amendment and the following remarks are respectfully requested. Claims 7-12 have been amended without prejudice or disclaimer.

Rejection of Claims 1-8 and 10-28 Under 35 U.S.C. §103(a)

The Office Action rejects claims 1-8 and 10-28 as being unpatentable over Sezan et al. (US Patent No. 6,236,395) (Sezan), in view of Chen et al. (US Patent No. 6,307,550) (Chen) and further in view of Slezak (US Patent No. 6,006,257) (Slezak). Applicants submit that the *prima facie* case for obviousness has not been met to combine Sezan, Chen, and Slezak.

To establish a *prima facie* case of obviousness, the Examiner must meet three criteria. First, there must be some motivation or suggestion, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to combine the references. Second, there must be a reasonable expectation of success, and finally, the prior art references must teach or suggest all the claim limitations. The Examiner bears the initial burden of providing some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." MPEP 2142.

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959), MPEP 2143.01, Section VI. *In re Ratti*, the court reversed the rejection holding

the "suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate." Id.

Furthermore, if the examiner determines there is factual support for rejecting the claimed invention under 35 U.S.C. 103, the examiner must then consider any evidence supporting the patentability of the claimed invention, such as any evidence in the specification or any other evidence submitted by the applicant. The ultimate determination of patentability is based on the entire record, by a preponderance of evidence, with due consideration to the persuasiveness of any arguments and any secondary evidence. *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). The legal standard of "a preponderance of evidence" requires the evidence to be more convincing than the evidence which is offered in opposition to it. With regard to rejections under 35 U.S.C. 103, the examiner must provide evidence which as a whole shows that the legal determination sought to be proved (i.e., the reference teachings establish a *prima facie* case of obviousness) is more probable than not. MPEP 2142.

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art, and all teachings in the prior art must be considered to the extent that they are in analogous arts. Where the teachings of two or more prior art references conflict, the examiner must weigh the power of each reference to suggest solutions to one of ordinary skill in the art, considering the degree to which one reference might accurately discredit another. *In re Young*, 927 F.2d 583, 18 USPQ2d 1089 (Fed. Cir. 1991). MPEP 2143.01.

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Slezak relates to providing interactive video programming to an individual subscriber, such as a cable television subscriber, and more particularly to a multimedia architecture that provides on-demand programming interleaved with secondary programming such as advertising to a subscriber wherein the content of the secondary programming is dependent upon information gathered from the viewer. Slezak teaches interleaving a secondary video signal in conjunction with primary programming. While a subscriber is watching a program, she can then view an advertisement. This would certainly be in contrast to Chen. Chen's whole purpose is to take segments of a video and combine them together to generate a photograph-based representative of the segment.

If the principle of operation of Chen or Slezak must be modified in order to accommodate their blending, there cannot be motivation to combine the references.

Chen requires taking a segment of video and rather than showing the video, pulling out individual portions and analyzing them to generate a video album as shown in Fig. 4 in which there are individual images and still images generated that are representative of the segment. Thus, at the core of Chen is the result of a series of still photographs, each representative of a separate segment of a video presentation. If the actual movie or video of Chen is ultimately modified and presented in still image fashion, this fundamentally differs from Slezak whose objective is providing interactive primary programming with interleaved advertising. While Chen focuses on a user who has home movies and/or personal videos that they may want to process in order to create a video album of their vacation as shown in Fig. 4, Slezak relates more to television viewing where on-demand programming, such as a pay-per-view movie, is selected and a secondary video stream is interleaved during the on-demand video programming to provide advertising.

The result of any combination of Chen and Slezak would be modifying or redesigning Chen such that the video album no longer exists. This is because it is a fundamental teaching of Slezak that there be a movie playing while advertising occurs. Thus, either Slezak's or Chen's fundamental teachings would have to be redesigned or modified. This fact would lead one of skill in the art away from combining their teachings. Furthermore, MPEP 2143.01(V) requires that the proposed modification cannot render unsatisfactory for its intended purpose. Thus if Chen were to be modified in order to blend in the teachings of Slezak, its approach of rendering still images would have to be abandoned as a fundamental purpose. In other words, there would be no realization of still images; the actual video would have to occur in order for there to be interleaved interactive advertising while viewing an on-demand primary programming as taught in Slezak. Similarly, if Chen were incorporated with Slezak, the basic concept of providing primary programming would have to be modified or eliminated in order to utilize the teachings of providing a video album that includes still images representing segments of video which is clearly contrary to the teachings of Slezak. Thus, the intended purpose of Slezak in view of presenting primary programming interleaved with secondary programming would have to be modified and its intended purpose would be frustrated if Slezak were combined with Chen.

Accordingly, applicants submit that the preponderance of the evidence is against there being sufficient motivation to combine Chen with Slezak, thereby rendering claims 1-8 and 10-28 patentable. Applicants respectfully request that the 35 U.S.C. 103(a) rejections be withdrawn.

CONCLUSION

Having addressed all rejections and objections, Applicants respectfully submit that the subject application is in condition for allowance and a Notice to that effect is earnestly solicited. If necessary, the Commissioner for Patents is authorized to charge or credit the **Novak, Druce & Quigg, LLP, Account No. 14-1437** for any deficiency or overpayment.

Respectfully submitted,

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